

Docket No.: K0502.70037US00
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Basil Karanikos et al.
Serial No.: 10/658,925
Confirmation No.: 3129
Filed: September 10, 2003
For: BEVERAGE FILTER CARTRIDGE
Examiner: J. Drodge
Art Unit: 1723

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Dated: September 23, 2009

Electronic Signature for Lisa R. Puopolo: /Lisa R. Puopolo/

REQUEST FOR REHEARING UNDER 37 CFR 41.52

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Decision on Appeal (Decision) dated July 24, 2009, Appellant requests rehearing in view of the points of law and/or fact detailed below that Appellant believes were overlooked or misapprehended by the Board in rendering its decision.

I. Spiteri's Teaching Regarding Applicability of Its Filter to Non-Drip Brewing Applications

Item 12 in the FINDINGS OF FACT section of the Decision indicates that "Spiteri is not limited to employing its fluted or pleated filter to an electric drip brewer; it teaches employing its fluted or pleated filter to any conventional coffee brewers which embraces those conventional coffee brewers taught by Sylvan (*id.*)" (emphasis added; *id.* refers to paragraph 0021 of Spiteri.)

This is not true. The relevant section of paragraph 0021 in Spiteri cited in the Decision states "The filter 10 is geometrically configured in size dimension and configuration to be received within the interior or [sic] a conventional coffee brewer means such as an electric drip brewer." While it is true that Spiteri describes that the filter can be used in "conventional coffee brewer means" and indicates that this "means" is not limited to an electric drip brewer, nothing in Spiteri teaches that the "conventional coffee brewer means" includes a closed beverage cartridge like that of Sylvan that receives injected, pressurized water to form a coffee beverage. Just because, in a vacuum, the term "conventional coffee brewer means" could embrace a wide variety of

different machines does not mean that one of skill in the art would interpret Spiteri as disclosing its filter could or should be used in any coffee brewing application. Instead, this statement in Spiteri should be interpreted as it would have been understood by one of skill in the art. Mr. Winkler provides his opinion in this regard in Section 9 of his Nov. 29, 2007 Declaration – i.e., that one of ordinary skill in the art would have understood the Spiteri filter to be useable in gravity-type drip brewing, that the functioning of a filter for drip-type brewing is quite different from that of a filter in a Sylvan-type cartridge, and that one of ordinary skill would not necessarily have concluded that a filter configuration suitable for use in drip-brewing would be suitable for use in a pressurized cartridge brewing application like Sylvan.

The Finding of Fact in Item 12 not only contradicts this evidence from Mr. Winkler, but also the plain teachings of Spiteri and Sylvan itself. Spiteri describes a filter that is used by being placed loosely in a brew basket, such that the sidewalls of the filter are unattached to the brew basket or other structure. Spiteri describes the virtue of its filter as having the ability to maintain the sidewall in an upright position and not sag or droop in the brew basket when water is added. (See paragraphs 0008 and 0009). In contrast, the filter in a Sylvan cartridge is fixed to the container at its top edge, and thus the sag or droop resistant sidewall of the Spiteri filter would not provide any advantage in a Sylvan cartridge, and thus would not have been seen as useful in a Sylvan cartridge.

Appellant submits that the Decision, in concluding that one of skill in the art would have understood the Spiteri filter to be suitable for use in a pressure-type beverage cartridge like that of Sylvan, supplants its own interpretation of Spiteri for that which one of skill in the art would have drawn. Appellants request reconsideration of this Finding of Fact, or at least clarification regarding how this understanding of Spiteri was arrived at, and what evidentiary support there is for such a conclusion. Spiteri's vague indication that the filter can be used in a "conventional coffee brewer means" does not support a conclusion that the filter is suitable for use in any coffee brewing application, including pressurized brewing applications like Sylvan.

II. Sylvan's Teaching Regarding Suitable Filter Shapes For Use in the Sylvan Cartridge

Item 5 of the FINDINGS OF FACT section of the Decision states: "Sylvan is not limited to employing a filter having a generally truncated cone shape or a truncated triangular prism (identical or similar to a fan shape) in its coffee filter cartridge; it teaches that its filter can be in any predetermined shape useful for its coffee filter cartridge (col. 2, ll. 8-16 and col. 3, ll. 13-15)." (emphasis added)

Sylvan does not teach that any filter shape would be useful in its cartridge. Specifically, the portions of Sylvan cited in Item 5 state the following:

"This invention features a beverage filter cartridge including an impermeable pierceable base having a predetermined shape and an opening at one end. There is a self-supporting wettable filter element disposed in the base sealingly engaged with the opening of the base and having a form different and smaller than the predetermined shape of the base so that the filter element

diverges from the base and divides the base into two sealed chambers.” (emphasis added; Sylvan col. 2, lines 8-16)

and

“The filter can have the shape of a cone, a truncated cone, or a triangular prism which fans out and blends into a circular base.” (Sylvan col. 3, lines 13-15)

These portions of Sylvan do not support the factual conclusion that Sylvan “teaches that its filter can be in any predetermined shape useful for its coffee filter cartridge.” To the contrary, Sylvan in the portion of column 2 cited in the Decision is specific that the filter has “a form different and smaller than the predetermined shape of the base so that the filter element diverges from the base.” Thus, this portion of column 2 is clear that the filter is configured in a particular way (i.e., is smaller and different than the base so the filter diverges from the base), not that a filter of any size, shape or configuration is suitable. Also, the portion of column 3 cited in the Decision provides only three different options for the filter arrangement (a cone, truncated cone or triangular prism), and does not state that other shapes are possible or should be used. Read in conjunction with the section of column 2 cited in the Decision, this listing of three filter shapes does not suggest that any filter arrangement will work in the Sylvan cartridge. To the contrary, these two sections of Sylvan suggest that a much more limited set of filter arrangements will function properly in the cartridge. Mr. Winkler confirms this in Sections 8 and 9 of his Nov. 29, 2007 Declaration, stating that one of skill in the art would not understand the Spiteri filter to be capable of maintaining a shape that is “different from and smaller than the predetermined shape of the base so that the filter element diverges away from the base” as required by Sylvan because the Spiteri filter would have been understood to expand radially with the injection of pressurized water such that the filter sidewall would contact the base (i.e., the filter would not diverge away from the base).

Appellant submits that drawing a conclusion that Sylvan teaches that its filter can be in any predetermined shape is not supported by the actual language of Sylvan or anywhere else in the record. Appellant requests reconsideration of this Finding of Fact.

III. Reason to Modify Based on Increasing Flow Rate

Section I of the ANALYSIS section finds that “one of ordinary skill in the art would have been led to employ the filter taught by Spiteri in Sylvan’s coffee filter cartridge in the manner suggested by Sylvan, with a reasonable expectation of successfully providing a desired high filtering function,” (sentence bridging pages 13 and 14 of the Decision), and that “Sylvan’s desires for a high flow rate would have led one of ordinary skill in the art to employ flutes or pleats in the side wall of the filter used in Sylvan’s coffee filter cartridge” (sentence bridging pages 12 and 13 of the Decision). To support this conclusion, the Decision states that a “pleated fan-shaped filter, according to Spiteri, requires adding an additional amount of the filter material (area) to a conventional fan shape filter. In other words, adding folds and pleats to the conventional fan-shaped filter provides a more effective filtering area (thus allowing a higher liquid flow rate as required by Sylvan).” (lines 1-5 of page 13 of the Decision).

The factual conclusion underlying these findings (i.e., that Sylvan teaches the desirability of increasing liquid flow rate in the cartridge, and therefore the desirability of increasing filter area) is inaccurate. Although Sylvan teaches that its cartridge has a high flow rate, nothing in Sylvan suggests that providing a higher flow rate than that of the disclosed cartridge arrangement is desirable. Thus, the notion that one of skill in the art would have been motivated to increase the flow rate of the cartridge (e.g., through the use of flutes or pleats in the filter of the Sylvan cartridge) is not taught or suggested by Sylvan. Even assuming that one of skill in the art would have believed the Spiteri filter to be useable in a cartridge like that of Sylvan, one of skill in the art would not have been motivated to make the asserted modification for at least the reason that such a modification would increase filter area and flow rate through the cartridge. That is, one of skill in the art would have understood that increasing the filter area and flow rate of a Sylvan cartridge would reduce the contact time between the brew water and the coffee, reducing the strength of the coffee beverage produced. Although unstated in Sylvan, it would have been understood that the cartridge must function to make a high quality coffee beverage. Blindly increasing flow rate of a Sylvan cartridge without regard for the quality of beverage formed is not something one of skill in the art would have done. Thus, one of skill in the art would not have been motivated to simply increase the flow rate through the Sylvan cartridge, particularly in view of the fact that Sylvan teaches that the disclosed arrangements have a high flow rate in an unmodified form (suggesting there is no need to further increase the flow rate), and that Sylvan does not teach that further increasing the flow rate is desirable.

Accordingly, Appellant requests reconsideration of the basis for finding that one of skill in the art would have been motivated to modify the Sylvan filter to include pleats or flutes, i.e., to increase filter area and flow rate through the cartridge.

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Dated:

SEPT. 23, 2009

Respectfully submitted,

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